

REMARKS

I. Status of the Claims

Upon entry of this Amendment, claims 19-23 and 31-40 will be pending. In the present Amendment, claims 14-18 and 24-30 are canceled without prejudice or disclaimer of the subject matter thereof. New claims 38-40 are added. Support for the new claims 38-40 can be found on page 4, lines 11-27, of the originally filed specification. Applicants have not introduced any new matter by the amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

II. Rejection under 35 U.S.C. § 102(e)

The Examiner maintained the rejection of claims 14-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,143,286 to Bhambhani et al. ("the '286 patent"). Final Office Action, page 2. Specifically, the Examiner points out that the '286 patent in Example 1 discloses "isostear[yl] citrate," which "is an ester formed f[ro]m citric acid, which is [a] 6-carbon carboxylic acid and isostearyl alcohol, which has 18 carbon atoms." *Id.* at page 3. Further, the Examiner alleges that the '286 patent "clearly discloses esters and names 20 esters that [do not constitute] a laundry list of esters." *Id.* Therefore, the Examiner concludes that "it is not picking and choosing the specific ester f[ro]m the 20 compounds named under esters for 'oily' [conditioning agents]." *Id.* Applicants respectfully disagree and transverse this rejection for the reasons of record and at least the following reasons.

First, the Examiner failed to establish that each and every element in claims 19-23 and 31-40 of the present invention is either expressly or inherently described in the '286 patent. Specifically, for example, the '286 patent does not expressly or inherently teach the "esters of formula (I):



wherein:

- R_1 is chosen from a branched (C_3 - C_5) hydrocarbon-based group, a monohydroxylated branched (C_3 - C_5) hydrocarbon-based group, and a polyhydroxylated branched (C_3 - C_5) hydrocarbon-based group" as recited in, for example, independent claim 19 of the present invention.

The term "hydrocarbon" is defined as "[a]n organic compound consisting exclusively of the elements carbon and hydrogen." *Hawley's Condensed Chemical Dictionary*, 14th ed., 2001, page 584. The isostearyl citrate disclosed in Example 1 of the '286 patent does not contain hydrocarbon-based groups or hydroxylated hydrocarbon-based groups as claimed, because the isostearyl citrate has more than one carboxylic group. The definitions of R_1 and R_2 do not encompass such carboxylic groups. Therefore, isostearyl citrate falls outside the scope of the esters of formula (I) as recited in Claim 19 of the present invention.

Second, the Examiner apparently neglects the teachings of the '286 patent as a whole by alleging that the '286 patent "clearly discloses esters and names 20 esters that [do not constitute] a laundry list of esters" and concluding that "it is not picking and choosing the specific ester f[ro]m the 20 compounds named under esters for 'oily' [conditioning agents]." See Final Office Action, page 3. Indeed, the '286 patent teaches

that its composition "may additionally contain . . . an oily conditioning agent which is an organic, nonvolatile oil." Col. 14, lines 28-31 (emphasis added). The '286 patent further teaches various types of the "oil" such as the esters of the formula RCO-OR' (col. 14, lines 37-52), glyceryl esters of fatty acids or triglycerides (col. 14, lines 53-58), other glyceryl esters (col. 14, lines 59-67), nonvolatile hydrocarbons (col. 15, lines 1-3), lanolin derivatives (col. 15, lines 4-6), fluorinated oils (col. 15, lines 7-12), sorbitan derivatives (col. 15, lines 13-18), and guerbet esters (col. 15, lines 19-54). The '286 patent does not provide any guidance in picking and choosing the esters of the formula RCO-OR' over other types of the "oil."

Moreover, focusing only on the disclosure of the esters of the formula RCO-OR', the '286 patent does not merely disclose 20 compounds as alleged by the Examiner, because in addition to the 20 specific examples of the esters, the '286 patent also discloses "fatty alcohols, such as oleyl alcohol, isocetyl alcohol, and the like, as well as the esters disclosed on pages 24-26 of the C.T.F.A. Cosmetic Ingredient handbook, First Edition, 1988" as examples of the esters of the formula RCO-OR'. Col. 14, lines 48-51. Not all of these examples of the esters fall within the scope of the present invention.

A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). Notably, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures" *Id.*

Here, because of the need for picking and choosing the specific examples of the esters from the disclosure of the '286 patent to arrive at the presently claimed invention, this rejection is improper. Accordingly, Applicants respectfully request this rejection be withdrawn.

III. Conclusion


In view of the cancellation of claims 14-18 and 24-30 and the foregoing remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned Applicants' representative at (202) 408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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